

PATENT
Application # 09/822,300
Attorney Docket # 2000P07515US01 (1009-087)

REMARKS

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The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 7, 19, 25, 35-37, 41, 44, 45, 51, and 52 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry. Support for the amendments to each of claims 44 and 51 can be found in the specification as originally submitted at least at page 9, lines 1-6; page 12, lines 11-22; and page 14, lines 3-14. It is respectfully submitted that no new matter has been added.

Claims 1-52 are now pending in this application. Claims 1, 19, 36, 39, 41, 44, and 51 are the independent claims.

I. The Objections to Claims 1, 19, 36, 39, 41, 44, 51

Each of claims 1, 19, 36, 39, 41, 44, 51 was objected to, at Page 2, because:

the following phraseology: industrial automation computer program *adapted for controlling* a programmable logic controller. If weight were to be given to the automation control program, the reciting of adapted for controlling does not allow it to happen, that is, such phraseology does not establish a patentable weight to the purpose of the automation program or its intended controller functionality, lacking details anywhere in the claims as to further characterize what are recited as industrial automation program and controlling a programmable logic controller. As a whole, the above limitation remains an intended use and is given no patentable

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weight; that is, the phrase adapted for is a vague language that lacks substance as to what is being done, absent any specific step describing how a intended target (a programmable logic controller) is being controlled. The above 'for controlling' limitation will be treated as though a programmable logic controller (PLC) can be a target for the applying any form or automation/control/design based on the recited control/automation program, and the specificity about such controlling process (if any) is not being given any weight or be entitled for proper merits.

Applicant respectfully traverses this objection. As an initial matter, the present Office Action presents no legal authority on which the claim objections are based. In addition, no binding legal authority is presented, or exists for that matter, that the present Office Action is entitled to accord no "patentable weight" to the functional limitations of the claimed "industrial automation computer program".

The Federal Circuit has interpreted the word "adapted" as preceding "functional language [that] limits the scope of these claims to devices that have the capability of" performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term "adapted."

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated "said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred." *See, In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

In yet another case, the Federal Circuit reversed an Examiner's rejection of a patent claim due to the Examiner's failure to provide patentable weight to **functional limitations**. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully submits that, for example, the "industrial automation computer program" that is "adapted for controlling a programmable logic controller", as recited in claim 1,

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are functional limitations that have been found to be entitled to patentable weight under at least, *R.A.C.C. Indus., Inc. and In re Land*.

For at least these reasons, it is respectfully submitted that any grounds for these objections are improper and should be removed, and respectfully request acknowledgment thereof.

II. The "Response to Arguments"

The Office Action mailed on 14 February 2007 (the "present Office Action") includes a section titled "Response to Arguments". To the extent that the "Response to Arguments" section attempts to characterize or mischaracterize any portion of Applicants Reply ("the Reply"), dated 20 December 2006, to the Office Action dated 19 April 2005 ("the prior Office Action"), such as by the numerous mischaracterizations regarding "Applicants' pattern of argument", Applicant respectfully traverses, and instead respectfully requests a response to the specific arguments presented by Applicant.

For example:

A. At Page 18, the present Office Action asserts:

[t]he pattern used by what appears to be Applicant's rebut resides in the 'where' statements; and the Examiner has not been able to acknowledge where the disagreement (by Applicants) against each of the cited portions lies in terms of specific technological (field of endeavor) details in regard to the very specific language of the claim. Establishing a prima facie case of rebut does not revolve around asking 'where' the cited parts are for a limitation; nor does it amount to pasting the entire Office Action without pointing out where the cited portions distinguish (in convincing and understandable terms) over the very language of a particular limitation (emphasis added). The pattern proffered in the Applicant's response as relying solely on asking questions, and these questions are, effected without pointing for each or most cited parts (set forth in any rejection) that are believed to raise a disagreement how the language of claimed feature distinguish over that particular referred to part of the reference (emphasis added). This does not help the Examiner perceive the difference so, to reply on specifics of the grounds of

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rejection (being applied), and hopefully determine whether they would still stand (or not) in view of the specific points identified by the arguments as explained above. Setting up questions without specifically directing them to the parts being applied in Dole amount to mere allegations that the prior art used does not match the claims; and this is not sufficient. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant respectfully traverses this assertion. As an initial matter, 37 CFR 1.111(c) is completely inapposite to the Reply since Applicant did not amend claims and 37 CFR 1.111(c) only applies when amendments are presented. Contrary to the assertion that Applicant did "not show how the amendments avoid such references or objections", Applicant submitted no amendments in the Reply. Applicant respectfully submits that the Reply referenced by the assertions fully complied with the requirements of 37 CFR 1.111(b).

Moreover, in properly traversing each purported claim rejection, Applicant pointed out deficiencies in the prior Office Action and, in particular, why no *prima facie* rejection of any claim was established by the prior Office Action. In addition, Applicant is not required to present a "*prima facie* rebut" [sic] when no *prima facie* rejection is presented. Because no *prima facie* rejection was presented, no burden shift occurred and Applicant had no rebuttal burden.

Applicant's Reply did not "rely[] solely on asking questions", but presented questions in order to highlight the deficiencies of the applied portions of the relied-upon references in failing to teach the claimed subject matter. Applicant respectfully notes that the present Office Action fails to reply to any of these questions. Also, Applicant respectfully submits that the assertion, "[s]etting up questions without specifically directing them to the parts being applied in Dole amount to mere allegations that the prior art used does not match the claims; and this is not sufficient" appears to be contrary to law. The applied portions of the relied-upon references must at least teach and enable all of the claimed subject matter. If "the prior art used" "does not match the claims" then no *prima facie* rejection of the claimed subject matter is presented. Indicating why no *prima facie*

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rejection of the claimed subject matter is presented satisfies the requirements of 37 CFR 1.111(b) and is proper.

B. At Page 19, the present Office Action asserts:

[a] As per the remarks presented against claims 2-18 (Appl. Rmrks, pg. 26-43), the pattern of Applicants' remarks are resumed from the previous pages; and can be summarized as: (i) pasting the Office Action, (ii) presenting the claim language, (iii) asserting that Dole does not teach some feature; (iv) asking where Dole discloses the claimed steps or features; (v) reciting the required steps taken (by an Examiner) for a obviousness *prima facie* case of rejection. These do not sufficiently amount to proper presentation of facts based on the referenced citations in Dole in regard to disagreeing with the corresponding claimed feature; and is referred back to section C above. It is urged that, instead of asking as in (iv), proper rebut should be formulating in terms of pointing to the cited portions corresponding to a particular feature, and doing so by laying out its weakness or inapposite teaching in language relevant to the field on the endeavor. The mere fact of asking where the prior art meets a claimed feature would be construed as asserting that nowhere (emphasis added) in the reference is taught any of the features claimed; and asserting that way (without identifying specific parts of the reference being applied in the Rejection) is insufficient to overcome a rejection, in accordance to the requirements of 37 CFR 1.111(c). Besides, the points raised against obviousness rationale are referred to section B

Applicant reiterates that no amendments were presented in the prior Reply and as such 37 CFR 1.111(c) is completely inapposite. Applicant respectfully points out that a *prima facie* rejection of claimed subject matter requires that the applied portions of the relied-upon references at least teach and enable all of the claimed subject matter. If the applied portions of the relied-upon references do not at least teach and enable all of the claimed subject matter, then no *prima facie* rejection is established. Applicant's arguments pointed out reasons why no *prima facie* rejection was presented regarding any claim in the present application. Asking questions can be an effective way to focus attention on the missing claimed subject matter. Applicant again

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respectfully notes that no answer was provided to any question asked, demonstrating further that the applied portions of the relied-upon references did not teach the claimed subject matter.

III. The Statutory Subject Matter Rejections

Each of claims 36-38, 44-49, and 51-52 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Each of these rejection is traversed as moot in view of the present amendments to each of claims 36, 44, and 51.

The Federal Circuit has held (internal citations omitted), in *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (quoting *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), cert. denied, U.S., 119 S. Ct. 851 (1999), that:

“[u]npatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting disembodied concepts or truths that are not ‘useful’ ... [T]o be patentable an algorithm must be applied in a ‘useful’ way.” In that case [referring to *State Street*], the claimed data processing system for implementing a financial management structure satisfied the 101 inquiry because it constituted a “practical application of a mathematical algorithm . . . [by] produc[ing] ‘a useful, concrete and tangible result.’”

Each of claims 36, 44, and 51, from one of which each of claims 37, 38, 45-49, and 52 ultimately depends, states, *inter alia*, “causing” a “programmable logic controller to control an industrial process via execution of an industrial automation computer program”, which Applicant respectfully submits is a “useful, concrete and tangible result”.

For at least these reasons, a withdrawal of each rejection of each of claims 36-38, 44-49, and 51-52 is respectfully requested.

IV. The Indefiniteness Rejections

Each of claims 36-38 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, the present Office Action states, at Page

These rejections are respectfully traversed. Regarding indefiniteness rejections, the Federal Circuit has held that the law is clear that **if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the**

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language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634 (Fed. Cir. 1985), *cert. dismissed*, 474 U.S. 976 (1985).

Applicant further reiterates that functional limitations following the phrase "adapted for" are not "a use" and respectfully requests a proper examination of claim 36.

Applicant also traverses the assertion on Page 6, "[t]he reciting of 'computer program' for 'controlling' (re claim 36) appears preemptive over any prior art of related field, and this is not sufficiently presenting distinguishing feature with respect thereto. This claim 36 is an omnibus type claim; and will be treated without proper merits in regard to such preemptive violation of the above way of claiming a feature." Applicant respectfully submits that this assertion fails to provide any legal or factual basis whatsoever on which a *prima facie* rejection under 35 U.S.C. 112 can be established.

Applicant respectfully submits that no evidence has been presented that claim 36, upon which each of claims 37 and 38 depends, when "read in light of the specification," does not "reasonably apprise those skilled in the art of the use and scope of the invention." Thus, no *prima facie* case has been made that claims 36-38 are indefinite. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 36-38.

V. The Obviousness Rejections

Each of claims 1-8, 10-12, 14-26, 28-30, 32-52 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. Dole ("6,634,008"), Webb, *Programming Logic Controllers' Principles and Applications*, Prentice-Hall, 1995, chp. 3, pp. 41-54 ("Webb"), and/or Applicant's own application as allegedly "Admitted Prior Art". Each of these rejections is respectfully traversed.

A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

Over 40 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

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1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The United States Supreme Court clarified the obviousness inquiry criteria in *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). The KSR Court held:

1. "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art";
2. "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art";
3. it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit"; and
4. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

In order to establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or

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references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, the burden of coming forward with evidence or argument shifts to the applicant." *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Allegedly "Admitted Prior Art"

According to the Federal Circuit "[o]nes own work may not be considered prior art in the absence of a statutory basis". *Riverwood International Corp. v. R. A. Jones & Co., Inc.*, 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003).

3. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., [a]ll words in a claim must be considered...." MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

4. Official Notice

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

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[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known**. For example, assertions of... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiners assertion of official notice, the examiner **must provide documentary evidence** in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (“[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

5. Inherency

Inherency “requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

6. Unfounded Assertions of Knowledge

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible

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substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

7. Interpreting "adapted"

The predecessor court to the Federal Circuit has interpreted the phrase "adapted" as preceding a "structural limitation". *See, In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by "adapted" have been considered sufficiently definite. *See* MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word "adapted" as preceding "functional language [that] **limits** the scope of these claims to devices that have the capability of" performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term "adapted."

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated "said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusable* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred." *See, In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

In yet another case, the Federal Circuit reversed an Examiners rejection of a patent claim due to the Examiners failure to provide patentable weight to **functional limitations**. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

8. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is "reasonably pertinent to the particular

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problem with which the invention was involved.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

“References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (“[I]t is necessary to consider the reality of the circumstances,—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor” (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

“If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (citing *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (quoting *Ecolchem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

9. Evidence of Obviousness – Combination of References

Under the *Graham* analysis, the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

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some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

10. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. See, *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

B. Analysis

1. All Claims

a. Allegedly Admitted Prior Art

Applicant has not admitted, and does not admit; that the applied portions of Applicant's own disclosure are prior art in the present application. The "Background" section represents subject matter "known" to Applicant. The mere fact that subject matter is "known" to an applicant does not expressly or impliedly suggest that the system is prior art. An applicant's own work can be "known" to an applicant without necessarily qualifying as prior art. Thus, since Applicant has not admitted that the Background section of the present application is prior art, it is improper for the Office Action to apply, or attempt to apply, portions of that Background section in a claim rejection under 35 U.S.C. 103(a).

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b. No Evidence that Dole is Pertinent Art

The present Office Action fails to even identify “the particular problem” the claimed subject matter is involved and notably fails to provide any evidence that Dole is “reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.”

The present Application states that the field of the invention is “graphical programming languages for programmable logic controllers. In particular, the invention concerns a method and system for standardized storage of graphical programming languages. *See* Page 1. By contrast, Dole allegedly recites, at the Abstract:

[a]n environment for designing integrated circuits. Computers include browsers for displaying pages of forms, with the computers in communication with a methodology server and a compute server. The methodology server contains design methodologies accessed by the computers, with the design methodologies defining steps of designing and testing of integrated circuits. The computers or methodology server are also in communication with a compute server. The compute server executes electronic design automation tools as requested.

Thus, Dole relates to designing and testing “integrated circuits”.

The present Office Action presents no evidence that Dole is “reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” Applicant respectfully submits that absent such evidence, Dole cannot be used in a *prima facie* rejection of any of claims 1-52.

1. Claim 1

Claim 1, from which each of claims 2-18 ultimately depends, recites, *inter alia*, “converting the internal representation to a markup language version of the industrial automation computer program”. The applied portions of the relied-upon references do not teach a “converting the internal representation to a markup language version of the industrial automation computer program”.

The present Office Action relies upon “Fig. 10; col. 16, lines 10-47; Fig. 13” of Dole as allegedly teaching this claimed subject matter. Yet none of these applied portions of Dole teach “converting” anything and notably do not teach, “converting the internal representation to a

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markup language version of the industrial automation computer program". Yet, FIG. 10 of Dole allegedly illustrates:

Applicant continues to respectfully ask, where does this relied upon FIG. 10 of Dole teach, "converting the internal representation to a markup language version of the industrial automation computer program"? Moreover, FIG. 13 of Dole allegedly illustrates:

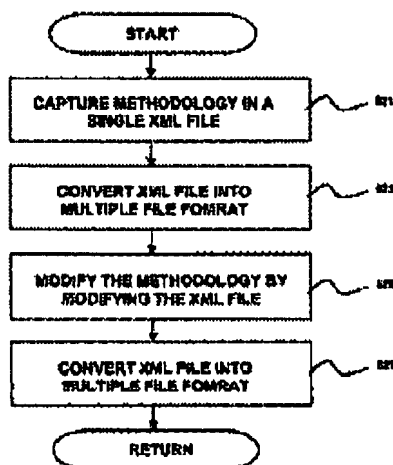


FIG. 13

Applicant respectfully asks; where does this relied upon FIG. 13 of Dole teach, "converting the internal representation to a markup language version of the industrial automation computer program"? Further, col. 16, lines 10-47 of Dole allegedly recite:

[a]lthough HTML based forms are typically used to capture design methodologies, it is often more desirable to use XML (Extensible Markup Language) script to define design methodologies because of advantages that XML has over HTML. In XML, information is divided into useful components called elements, e.g., titles, paragraphs and part numbers. The elements may be formatted, sorted, or searched in consistent fashion. The elements are typically named and defined in a computer program called a Document Type Definition (DTD)

Using XML, a methodologist is able to create a single file to describe each design methodology. The single file that describes the design methodology may be used

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to create other files needed to execute the design methodology. For example, new features can be added to XML over time since XML is an extensible language. In addition, parsers are easy to develop using XML. For example, the parsers may be partially generated automatically from the DTD. Further, XML sources may be scanned by various different programs for different purposes. For example, a source code based on XML may be scanned by a search engine.

Another benefit of using XML is that XML is capable of providing multiple language support. For another example, an XML file is easy to create provided that a good DTD has been created. In addition, an XML-based DTD file may be used to specify the internal nature of the XML files used to define design methodologies. Further, XML hyper-linking is more powerful than HTML hyper-linking, and XML hyper-linking may be used to refer to parts of other XML files. Widely used web browsers may not have a capability to display pages having embedded XML. Therefore, in an alternate embodiment, rather than using an input page to capture design methodology, a methodologist creates an XML script defining a design methodology in a single file. In this embodiment, the XML files are used by Common Gateway Interfaces (CGI's) to drive the integrated circuit design and fabrication system rather than directly viewed using a browser.

Applicant respectfully asks, where does this relied upon portion of Dole teach:

1. "converting" anything?
2. "converting" anything "to a markup language version"?
3. "an internal representation [of an industrial automation control program adapted for controlling a programmable logic controller]"?
4. **"converting the internal representation to a markup language version of the industrial automation computer program"?**

Applicant respectfully submits that at least this claimed subject matter is absent from the applied portions of Dole. The applied portions of the remaining applied portions of the relied-upon references do not overcome at least these deficiencies of Dole.

The present Office Action fails to answer any of the questions asked by Applicant requesting a detailed explanation regarding the specific language of the alleged teachings of the

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applied portions of the relied-upon references purported to render the claimed subject matter obvious.

For at least these reasons, Applicant respectfully submits that the assertions of the present Office Action fail to comply with MPEP 707.07, which requires that a proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of the submitted arguments.

Thus, even if there were evidence of obviousness (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Moreover, Applicant respectfully submits that the present Office Action fails to properly address the Graham factors by at least failing to determine the scope and contents of the prior art; resolve the level of ordinary skill in the pertinent art; and consider objective evidence indicating obviousness or nonobviousness.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 1. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 1. A withdrawal of each of claims 2-18, each of which ultimately depends from claim 1 is also respectfully requested.

2. Claim 5

Claim 5 recites, yet the present Office Action **fails to allege** that any of the applied portions of the relied-upon references teaches, "representing the retrieved industrial automation computer program as a corresponding graphical programming language version on a computer display." The present Office Action fails to substantively respond to this persuasive argument and again fails to provide any evidence of obviousness regarding claim 5.

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Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 5. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 5.

3. Claim 17

Claim 17 states, *inter alia*, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "retrieving the markup language version of the industrial automation computer program from the computer data storage device and representing the retrieved industrial automation computer program as a corresponding graphical programming language version on a computer display." Since claim 17 ultimately depends from claim 1, the "industrial automation computer program" is "adapted for controlling a programmable logic controller". The applied portions of Dole do not teach, "industrial automation computer program" that is "adapted for controlling a programmable logic controller" and thus cannot teach "retrieving the markup language version of the industrial automation computer program from the computer data storage device and representing the retrieved industrial automation computer program as a corresponding graphical programming language version on a computer display."

The applied portions of Hoskins fail to cure at least these deficiencies of the applied portions of Dole.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 17. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 17.

4. Claim 19

Claim 19, from which each of claims 20-35 ultimately depends, recites, *inter alia*, "converting the identified industrial automation computer program from the internal representation to a markup language version of the industrial automation computer program". The applied portions of the relied-upon references do not teach a "converting the identified industrial automation computer program from the internal representation to a markup language version of the industrial automation computer program".

The present Office Action relies upon "Fig. 10; col. 16, lines 10-47; Fig. 13" of Dole as

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allegedly teaching this claimed subject matter. Yet none of these applied portions of Dole teaches “converting” anything and notably do not teach, **“converting the identified industrial automation computer program from the internal representation to a markup language version of the industrial automation computer program”**. Yet, FIG. 10 of Dole allegedly illustrates:

Applicant continues to respectfully ask, where does this relied upon FIG. 10 of Dole teach, **“converting the identified industrial automation computer program from the internal representation to a markup language version of the industrial automation computer program”**? Moreover, FIG. 13 of Dole allegedly illustrates:

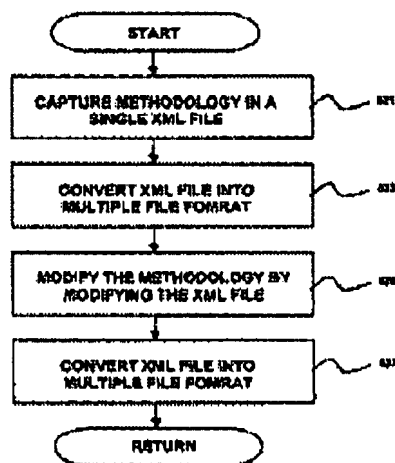


FIG. 13

Applicant respectfully asks; where does this relied upon FIG. 13 of Dole teach, **“converting the identified industrial automation computer program from the internal representation to a markup language version of the industrial automation computer program”**? Further, col. 16, lines 10-47 of Dole allegedly recite:

[a]lthough HTML based forms are typically used to capture design methodologies, it is often more desirable to use XML (Extensible Markup Language) script to define design methodologies because of advantages that XML has over HTML. In XML, information is divided into useful components called elements, e.g., titles, paragraphs and part numbers. The elements may be

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formatted, sorted, or searched in consistent fashion. The elements are typically named and defined in a computer program called a Document Type Definition (DTD)

Using XML, a methodologist is able to create a single file to describe each design methodology. The single file that describes the design methodology may be used to create other files needed to execute the design methodology. For example, new features can be added to XML over time since XML is an extensible language. In addition, parsers are easy to develop using XML. For example, the parsers may be partially generated automatically from the DTD. Further, XML sources may be scanned by various different programs for different purposes. For example, a source code based on XML may be scanned by a search engine.

Another benefit of using XML is that XML is capable of providing multiple language support. For another example, an XML file is easy to create provided that a good DTD has been created. In addition, an XML-based DTD file may be used to specify the internal nature of the XML files used to define design methodologies. Further, XML hyper-linking is more powerful than HTML hyper-linking, and XML hyper-linking may be used to refer to parts of other XML files. Widely used web browsers may not have a capability to display pages having embedded XML. Therefore, in an alternate embodiment, rather than using an input page to capture design methodology, a methodologist creates an XML script defining a design methodology in a single file. In this embodiment, the XML files are used by Common Gateway Interfaces (CGI's) to drive the integrated circuit design and fabrication system rather than directly viewed using a browser.

Applicant respectfully asks, where does this relied upon portion of Dole teach:

1. "converting" anything?
2. "converting" anything "to a markup language version"?
3. **"converting the identified industrial automation computer program from the internal representation to a markup language version of the industrial automation computer program"?**

Applicant respectfully submits that at least this claimed subject matter is absent from the applied

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portions of Dole. The applied portions of the remaining applied portions of the relied-upon references do not overcome at least these deficiencies of Dole.

The present Office Action fails to answer any of the questions asked by Applicant requesting a detailed explanation regarding the specific language of the alleged teachings of the applied portions of the relied-upon references purported to render the claimed subject matter obvious.

For at least these reasons, Applicant respectfully submits that the assertions of the present Office Action fail to comply with MPEP 707.07, which requires that a proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of the submitted arguments.

Thus, even if there were evidence of obviousness (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Moreover, Applicant respectfully submits that the present Office Action fails to properly address the Graham factors by at least failing to determine the scope and contents of the prior art; resolve the level of ordinary skill in the pertinent art; and consider objective evidence indicating obviousness or nonobviousness.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 19. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 19. A withdrawal of each of claims 20-35, each of which ultimately depends from claim 19 is also respectfully requested.

5. Claim 23

Since claim 23 is dependent upon claim 20, Applicant respectfully incorporates by reference each traversal of the present Office Action regarding claim 20, *supra*.

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Claim 23 recites, yet the present Office Action **fails to allege** that any of the applied portions of the relied-upon references teaches, “representing the retrieved industrial automation computer program as a corresponding graphical programming language version on a computer display.”

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 23. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 23.

6. Claim 39

Claim 39 recites, *inter alia*, “**converting the industrial automation computer program, stored in memory in the internal representation, from the internal representation to a markup language version of the industrial automation computer program**”. The applied portions of the relied-upon references do not teach a “**converting the industrial automation computer program, stored in memory in the internal representation, from the internal representation to a markup language version of the industrial automation computer program**”.

The present Office Action relies upon “col. 7, lines 26-42; Fig. 10;” and “col. 16, lines 10-47; Fig. 13” as allegedly teaching “**computer program code adapted for converting the industrial automation computer program, stored in memory in the internal representation, from the internal representation to a markup language version of the industrial automation computer program**”. Each of Fig. 10, col. 16, lines 10-47, and Fig. 13 are presented, *supra*, regarding the traversal of claim 1. Dole allegedly recites, at col. 7, lines 26-42:

[t]he interface and flow control tool encompasses HTML pages and CGI scripts. The HTML pages include input forms for defining methodologies, including steps of methodologies, as well as chip and block home pages and executable methodologies. The CGI scripts receive and act on data input to the input forms to create files defining methodologies, chips and blocks, and executable methodologies attached to chips and blocks. The CGI scripts also cause execution of electronic design automation (EDA) tools residing on the compute servers (illustrated in FIG. 2).

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Accordingly, the design server contains files 303. The files are created by the CGI scripts in response to input to the input forms applying new methodologies, and responsive to input to input forms attaching methodologies to chips or blocks. In addition, in one embodiment the files include files and libraries comprising design data formed as the result of the execution of the EDA tools.

Applicant respectfully asks, where does this relied upon portion of Dole teach:

4. "converting" anything?
5. "converting" anything to "a markup language version"?
6. "an internal representation [of an industrial automation control program adapted for controlling a programmable logic controller]"?
7. **"converting the industrial automation computer program, stored in memory in the internal representation, from the internal representation to a markup language version of the industrial automation computer program"?**

Applicant respectfully submits that at least this claimed subject matter is absent from the applied portions of Dole. The applied portions of the remaining relied upon references do not overcome at least these deficiencies of Dole.

Thus, even if there were evidence of obviousness (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Moreover, Applicant respectfully submits that the present Office Action fails to properly address the Graham factors by at least failing to determine the scope and contents of the prior art; resolve the level of ordinary skill in the pertinent art; and consider objective evidence indicating obviousness or nonobviousness.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 39. For at least these reasons, Applicant respectfully requests a

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withdrawal of the rejection of claim 39. A withdrawal of claim 40, which ultimately depends from claim 39, is also respectfully requested.

7. Claim 41

Claim 41, from which each of claims 42 and 43 ultimately depends, recites, *inter alia*, "creating a schema defining a content model for a markup language version of an industrial automation computer program converted from a graphical language version of the industrial automation computer program, the industrial automation computer program adapted for controlling a programmable logic controller". The present Office Action alleges that this claimed subject matter is taught by Dole at "synthesis tool, behavioral model, schematic – col. 12, lines 5-48; DAG - col. 16, lines 52-55; col. 17, lines 22-27; Fig. 23; step 405-407 - Fig. 9; col. 12, lines 42-55".

Yet, Dole allegedly recites, at col. 12, lines 5-48:

[a]fter the specification phase, a series of steps 405, 407, 409, 411, 413, 415 are carried out that result in a physical design of the circuit. Each step in the design process may require one or more iterations until that stage of the design has been satisfactorily completed. Also, after two or more steps are completed, it may be realized that the cumulative solution obtained at the stage is inadequate and must be reiterated. Tracking of the design process is therefore sometimes difficult. The problems of tracking progress of the design process is compounded when design teams implementing each task are located in remote locations, making communications difficult.

Step 405 of the process is the generation of a register transfer level (RTL) model. Generation of the RTL model is required if no preexisting block exists, such as when a block must be designed from scratch. The RTL model represents the block behavior of the design. The RTL model is a synthesizable behavioral model that is translated into a structural model providing a logic level description of the system. The generation of the RTL model is accomplished using methodologies previously selected.

Step 407 of the process is the synthesis of the circuitry necessary to implement the

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logic functions of the RTL model. The designer synthesizes the circuit using a methodology including a synthesis tool. The methodology corresponds to one or some of the methodologies previously selected. An analysis program optionally may be executed as part of this step, with the analysis program used to verify that the output of the synthesis step behaves in accordance with the product specification. The use of the analysis program is generally specified as a separate methodology, although it may be a sub-methodology or step of the synthesis methodology.

Step 409 of the process is simulation of the overall design. All of the components of the design are assembled and a simulation is run. The simulation tool, test vector generation, and other matters are determined by the selected methodologies. The design is adjusted until satisfactory simulation results are obtained. At this point in the design cycle, a satisfactory design consists of a schematic that contains components such as transistors that may be built on the integrated circuit, and that when simulated using appropriate models give appropriate results. This model generally does not take into consideration the physical layout of these components on the integrated circuit substrate.

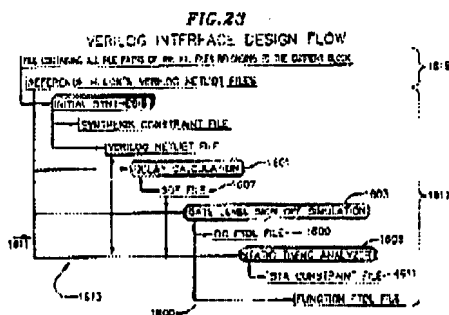
Further, Dole allegedly recites, at col. 1, lines 52-55, "[a]ccordingly, each of the blocks must be supported by a testing tool used to verify the functionality of the integrated circuit as a whole."

Dole allegedly recites, at col. 17, lines 22-27:

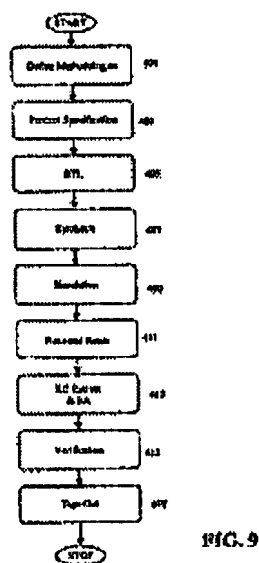
[n]ext, a converter with XML parsing capability is used in step 523 to convert the captured design methodology into multiple files including info and index files as well as a directed acyclic graph (DAG) file.

Dole allegedly illustrates at FIG. 23:

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Dole allegedly illustrates at FIG. 9:



Dole allegedly recites, at col. 12, lines 42-55:

[a]t this point in the design cycle, a satisfactory design consists of a schematic that contains components such as transistors that may be built on the integrated circuit, and that when simulated using appropriate models give appropriate results. This model generally does not take into consideration the physical layout of these components on the integrated circuit substrate.

Step 411 of the process is placing the components of the design on the substrate and routing of signal to and from the components. Place and route is generally accomplished using one or more place and route tools. The place and route tools used are specified by the selected methodologies. The output of the place and

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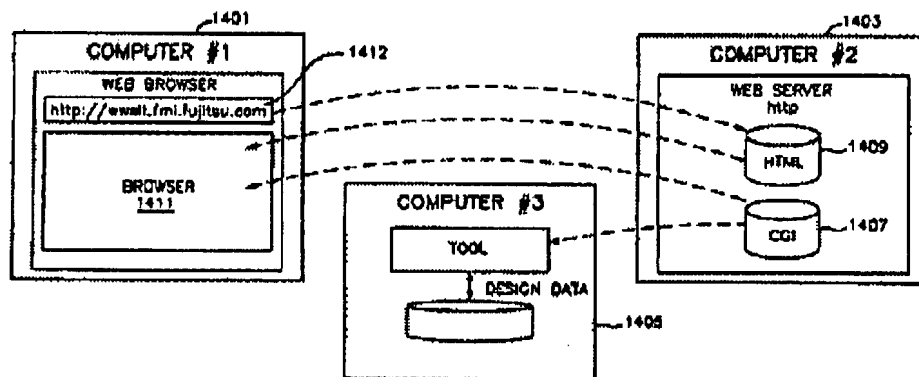
route is a representation physical layout of the integrated circuit as it is built.

Applicant respectfully asks for an explanation regarding how and where any of these applied portions of Dole teach a “creating a schema defining a content model for a markup language version of an industrial automation computer program converted from a graphical language version of the industrial automation computer program, the industrial automation computer program adapted for controlling a programmable logic controller”. Applicant respectfully submits that no applied portion of any relied upon reference teaches at least this claimed subject matter.

Claim 41 recites, “posting the schema for access over a network by application developers.”

The present Office Action relies upon “Fig. 5; Fig. 13” as allegedly teaching “posting the schema for access over a network by application developers”. FIG. 13 is presented, *supra*, regarding the traversal of claim 1. Dole allegedly illustrates, at FIG 5:

FIG. 5



Applicant respectfully asks, where do either of the relied upon portions of Dole teach, “posting the schema for access over a network by application developers”? Applicant respectfully submits that at least this claimed subject matter is absent from the applied portions of Dole. CThe applied portions of the remaining relied upon references do not overcome at least these deficiencies of Dole.

The present Office Action fails to answer any of the questions asked by Applicant requesting a detailed explanation regarding the specific language of the alleged teachings of the

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applied portions of the relied-upon references purported to render the claimed subject matter obvious.

For at least these reasons, Applicant respectfully submits that the assertions of the present Office Action fail to comply with MPEP 707.07, which requires that a proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of the submitted arguments.

Thus, even if there were evidence of obviousness (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Moreover, Applicant respectfully submits that the present Office Action fails to properly address the Graham factors by at least failing to determine the scope and contents of the prior art; resolve the level of ordinary skill in the pertinent art; and consider objective evidence indicating obviousness or nonobviousness.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 41. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 41. A withdrawal of each of claims 42 and 43, each of which ultimately depends from claim 41, is also respectfully requested.

8. Claim 42

Claim 42 states, yet the present Office Action fails to allege that any applied portion of any relied upon reference teaches, "wherein the schema is an XML schema".

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. See MPEP 707.07(d). For example, dependent claim 42 states, *inter alia*, "wherein the schema is an XML schema". The omnibus rejection of claim groups by the

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references relied upon in the Office Action makes no mention of "wherein the schema is an XML schema", and fails to point out where, in any of the references, that limitation is disclosed.

In view of the failure of the Office Action to satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

For at least these reasons, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 42. For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 42.

9. Claim 44

Applicant respectfully submits that the rejection of claim 44 is moot in view of the present amendments to claim 44. Claim 44 states, yet the applied portions of the relied-upon references do not teach, "a binary Common Object Model formatted internal representation converted to provide the markup language version of the industrial automation computer program".

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 44. A withdrawal of each of claims 45-50, each of which ultimately depends from claim 44, is also respectfully requested.

10. Claim 46

Claim 46 states, *inter alia*, yet the applied portions of Dole fail to teach, "wherein the step of transmitting the accessed, markup language version of the industrial automation computer program over the network comprises sending an electronic mail message."

The present Office Action takes Official Notice, at Page 14, that:

in an enterprise wherein multiple users are connected via the enterprise network services such that network communication and data distribution help fulfill the enterprise business applications, the use electronic mail to communicate data or update information was a well-known concept at the time the invention was made. The providing of electronic mail to Dole's system so as to enable multiple developers to communicate with the common framework to retrieve markup-formatted control data would have been obvious in light of the benefits related to

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such type of communications as suggested by the well-known concept from above

Thus, to the extent that Official Notice is utilized to support the rejection of claim 46, this rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested.

11. Claim 51

Applicant respectfully submits that the rejection of claim 51 is moot in view of the present amendments to claim 51. Claim 51 states, yet the applied portions of the relied-upon references do not teach, "a set of tags associated with the markup language version of the industrial automation software defined for a graphical language used in industrial automation, the graphical language associated with the industrial automation computer program, the set of markup language tags one of a plurality of sets of markup language tags, each set of markup language tags of the plurality of sets of markup language tags defined for a corresponding graphical language of a plurality of graphical languages used in industrial automation".

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 51. A withdrawal of claim 52, which depends from claim 51, is also respectfully requested.

VI. The Present Office Action Fails to Respond to All of Applicant's Arguments

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicant's submitted arguments. *See* MPEP 707.07(f).

In response to the Office Action 22 October 2006, Applicant filed a proper Reply dated 20 December 2006. That Reply is incorporated herein by reference in its entirety. The present Office Action fails to answer in detail the substance of Applicant's arguments regarding at least each of independent claims 1, 19, 36, 39, and 41. Rather than respond in detail to each of these arguments, the present Office Action merely mischaracterized these arguments, criticized the form of the arguments, and alleged noncompliance thereof with an inapposite standard. *See* section II, *supra*.

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VII. The Finality of the Office Action is Improper, Premature, and should be Withdrawn

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicants submitted arguments. *See* MPEP 707.07(f).

As stated above, the present Office Action failed to respond in detail to Applicant's arguments regarding at least each of independent claims 1, 19, 36, 39, and 41.

For at least these reasons, Applicant respectfully requests that the finality of the 18 May 2005 Office Action be withdrawn.

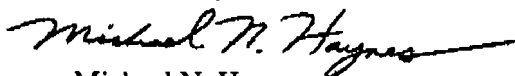
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



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Date: 23 May 2007

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